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EXPEDITED PROCEDURE

Docket No.: 300.1158

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Yoji ASAH, et al.

Serial No. 10/827,318

Group Art Unit: 2814

Confirmation No. 4043

Filed: April 20, 2004

Examiner: TRINH, Hoa B.

For: SEMICONDUCTOR DEVICE SUBSTRATE

**LETTER TO THE EXAMINER AND REQUEST
FOR WITHDRAWAL OF FINAL STATUS AS PREMATURE**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Attention: **BOX AF**

Sir:

Applicants submit that the finality of the current Office Action mailed February 13, 2008 ("current Office Action") is premature since the Examiner's response is incomplete. The Examiner has not addressed all of the Applicants' arguments in the previous Amendment filed November 9, 2007 ("previous Amendment") traversing the rejections in the previous Office Action mailed August 9, 2007 ("previous Office Action").

As set forth in MPEP §707.07(f) entitled Answer All Material Traversed:

an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

I. In item 4, pages 2-4 of the current Office Action, the Examiner again rejects claims 1-10 under 35 U.S.C. §103(a) as being unpatentable over Abe (U.S. Pub. 2003/0136577 with assertions in support of the rejection the same as in the previous Office Action.

In the previous Amendment, Applicants argued there is no "rational underpinning" to support the modification of Abe as the Examiner asserts, and the Examiner's assertions that "resin layers . . . may be selected among the disclosed group of materials . . . so as to provide the outermost layer with the higher strength and elongation than the inner layer because the results are (merely) predictable" are merely conclusory and without articulated reasoning.

In addition, Applicants argued by contrast, Abe's teachings are directed to a core substrate "formed of a fiber reinforced metal," and advantages over the prior art are directed to Abe's teaching of a use of fibers. Applicants further argued that while the Examiner asserted that it would have been obvious to modify Abe for "preventing cracking" Abe does not address cracking, at all.

However, in the current Office Action, the Examiner does not address Applicants arguments, but merely asserts:

A semiconductor substrate may be made of a silicon substrate, thereby making the core layer suitable for the claimed limitation. Furthermore, the selection of material for the insulating layer is obvious because the result is predictable.

(Emphasis added, Current Office Action at page 6, lines 14-17).

Applicants submit that the Examiner's statement "the result is predictable" is not supported. As set forth, for example, in MPEP § 2144.03(a) "the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute."

In addition, there is no evidence supporting the Examiner's assertions. See MPEP §2144.03(b) ("there must be some form of evidence in the record to support an assertion of common knowledge").

Thus, Applicants demand that complete arguments include required support for such a statement, or if the statement is based on the Examiner's personal views, the Examiner provide an affidavit as required under 37 C.F.R. §1.104(d)(2).

II. In item 5 at page 5 of the current Office Action, the Examiner rejects claims 11-15 under 35 U.S.C. §103(a) as being unpatentable over Abe in view of art Nair (U.S. Pub. 2004/0095734) with assertions that are the same as in the previous Office Action.

In traversing the rejection of claims 11-15 in the previous Amendment, Applicants argued the Examiner's assertions regarding a reasonable chance of success to combine the art are in error since Abe specifically teaches a metal alloy has a thermal coefficient expansion that is larger than a thermal expansion coefficient of silicon and for a core substrate to have a thermal expansion coefficient substantially equal to that of silicon, the core substrate needs to be a composite material.

Thus, Applicants argued the Examiner's assertion that it would have been reasonable to modify a composite material core substrate disclosed by Abe to be an iron-nickel alloy material is in error. Applicants argued the elements in combination do not merely perform the

function that each element performs separately and the results of the claimed combination were unexpected.

However, the current Office Action, the Examiner does not address these arguments.

III. As set forth in MPEP § 706.07(d):

(I)f, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.

Thus, Applicants respectfully request that the finality of the current Office Action be withdrawn and another action issued including a complete response and with the due date accordingly reset.

If there are any additional fees associated with filing of this Letter, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: April 22, 2008

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